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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Timothy Baker

Serial No.: 10/648,048

Conf. No.: 3223

Filed: 08/26/2003

For: POWER HAND TOOL RIGHT ANGLE ATTACHMENT HAVING A LIGHT SOURCE WITH A SELF-GENERATING POWER SUPPLY

Art Unit: 3724

Examiner: Choi, Stephen

*I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.*

*Date* 12/13/07

*Attorney for Applicant(s)*
*Registration No.* 26174

**TRANSMITTAL OF APPEAL BRIEF IN RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF**

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is the Appeal Brief in this application in response to the Notification of Non-Compliant Appeal Brief dated November 14, 2007.

The fee in the amount of $500.00 was paid on April 20, 2006.

The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment to Deposit Account No. 07-2069. Should no proper payment be enclosed, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. (One additional copy of this Notice is enclosed herewith.)

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

December 13, 2007

By

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PATENT APPLICATION



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12/13/07
*Date*

*Attorney for Applicant(s)*
*Registration No.* 26,774

**APPELLANT'S CORRECTED BRIEF ON APPEAL PURSUANT TO 37 CFR § 41.37**

This Appeal Brief is in support of Applicant's Notice of Appeal dated February 21, 2006.

## REAL PARTY IN INTEREST

Credo Technology Corporation.

## RELATED APPEALS AND INTERFERENCES

None.

## STATUS OF CLAIMS

Claims that are pending, finally rejected and appealed are 1-4 and 6-10. Claims 5, 11 and 13 have been allowed and claims 12 and 14 have been cancelled.

## STATUS OF AMENDMENTS AFTER FINAL

An amendment B was filed January 23, 2006 in which claim 11 was amended to place it in independent form. In an Advisory action mailed February 6, 2006, the Examiner indicated that for purposes of appeal, claims 5, 11 and 13 are allowed.

## SUMMARY OF CLAIMED SUBJECT MATTER

The present invention generally concerns power hand tools, specifically a right angle attachment for the same.

A preferred embodiment of the preferred invention comprises a right angle attachment for a power hand tool of the type which has a generally cylindrical elongated housing with a motor contained within the housing or case and the motor having an output shaft that extends from the nose end of the hand tool. The attachment has a housing with a mounting end that fits on the nose end portion of the tool housing, with the housing having an input shaft

and an output shaft that are operatively coupled together by bevel gears attached to each shaft. A magnet is mounted on the output shaft near an electric circuit located within the housing for producing current that drives the LED's. Since the magnet and the circuit are inside the housing, a lens is provided in the housing adjacent the light producing device for emitting light to the exterior of the housing and toward the tool attached to the distal end.

More particularly, the only independent claim, which is claim 1 is annotated with references to the specification and drawings, as follows:

1. A right angle (Pg 4/26-28) attachment (10, Fig. 1A, Pg 3/12-22) for a power hand tool (20, Fig. 1B) of the type which has an elongated generally cylindrical housing containing a motor having a motor output shaft (28, Fig. 1B) extending from a nose end thereof, the housing having a generally cylindrical nose end portion (22, Fig. 1B) that is concentric with said motor output shaft, said nose end portion providing a structure on which said attachment can be mounted (Pg 3/12-22), said attachment comprising:

a housing (12, Fig. 3) having a mounting end (14, Fig. 3) and a distal end (16, Fig. 3), with the mounting end having a cylindrical opening (18, Fig. 3) sized to snugly fit on the nose end portion of the tool housing (Pg 3/12-17);

said housing (12) having an input shaft (30, Fig. 3, Pg 3/22-27) journaled in bushings and having an engaging recess (32, Fig. 3, Pg 3/22-27) at one end portion for engaging a drive shaft that is driven by the motor output shaft (28), and an attached gear (44, Fig. 4, Pg 4/12-15) at the opposite end;

said housing (12) having an output shaft (48, Fig. 4, Pg 4/12-20) journaled in bushings, said output shaft being configured to rotate a tool attached to said distal end, and having a gear (46, Fig. 4, Pg 4/12-20) attached to its opposite end portion ;

said input shaft gear (44) engaging said output shaft gear (46) at a generally 90 degree angle (Fig. 4) so that said motor output shaft drives said accessory output shaft (46);

a magnet (74, Figs. 4 & 6, Pg 4/8-13) mounted on said output shaft (46) and an electrical circuit (60, Figs 4-7, Pg 4/21-5/20) mounted in said attachment housing adjacent said magnet for producing power, said circuit including at least one light producing device (66);

a lens (70, Figs 1A, 5 & 6, Pg 4/29-5/8) in said housing adjacent said light producing device (66) for admitting light to the exterior of said housing toward a tool attached to said distal end.

## GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether the §103(a) rejection of claims 1-4 should be reversed as being an improper rejection based upon the combination of the Maier and Anderson references.

Whether the §103(a) rejection of claims 1-4, 8 and 9 should be reversed as being an improper rejection based upon the combination of the Kopras and Anderson references.

Whether the §103(a) rejection of claims 6 and 7 should be reversed as being an improper rejection based upon the combination of the Rubly, Maier, Dukess, Anderson Kopras and Wu references.

## ARGUMENT

### Claim 1 Is Improperly Rejected Based Upon The Combination Of Maier And Anderson

The examiner has rejected claims 1-4 and 8-10 under 35 U.S.C. 103(a) as being unpatentable over Maier in view of Anderson. Applicant has made several arguments about the improper nature of the combination of these two patents, in addition to the combination of up to five separate patents in the rejection of dependent claims. In addition, the examiner has used conclusory statements of other "old" features to make certain rejections. Such combinations smack of improper hindsight. Yet, in the examiner's response to applicant's arguments, the examiner has totally ignored the argument that the examiner has improperly used hindsight to reject these claims.

The Court of Appeals for the Federal Circuit has just published the decision of *In re Kahn,* __ F.3d __ (Fed. Cir. 2006)(Linn, J.). The court in *Kahn* for the first time explains the Federal Circuit motivation test in the context of both *Graham* and *Dann v. Johnston.* After quoting from *Dann v. Johnston*, the court in *Kahn* explains that "[b]y requiring the Board to explain the motivation, suggestion, or teaching as part of its prima facie case, the law guards against hindsight ... which advances Congress's goal of creating a more practical, uniform, and definite test for patentability. See *Dann*, 425 U.S. at 225-26 ('[I]t was only in 1952 that Congress, in the interest of 'uniformity and definiteness,' articulated the requirement in a statute.' (quoting S.Rep. No.1979, at 6 (1952); H.R.Rep. No.1923, at 7 (1952))); *Graham*, 383 U.S. at 17 ('The § 103 [test], when followed realistically, will permit a more practical test of patentability.')."

Acknowledging that the "motivation" test did not originate with the Supreme Court, *Kahn* seeks to reconcile this test with *Graham* and *Dann v. Johnston:* "Although [the CCPA] was the first [court] to articulate the motivation-suggestion-teaching test, a related test – the 'analogous art' test –

has long been part of the primary Graham analysis articulated by the Supreme Court."

The *Kahn* panel explains that "[t]he analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker,* 977 F.2d 1443, 1447 (Fed.Cir.1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* ('[I]t is necessary to consider 'the reality of the circumstances,' – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.' (quoting *In re Wood,* 599 F.2d 1032, 1036 (C.C.P.A.1979))). We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight. See *id.; In re Clay,* 966 F.2d 656, 659-60 (Fed.Cir.1992)."

The court then differentiates between the "analogous art" test of *Graham* and the "motivation" test of the Federal Circuit:

> "The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the *Graham* analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law, see § 103(a); *Graham*, 383 U.S. at 35; *Dann*, 425 U.S. at 227-29, and helps ensure predictable patentability determinations."

In *Kahn*, the court noted that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be

some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *[In re] Lee*, [277 F.3d 1338,] 1343-46 [(Fed.Cir.2002)]; *[In re] Rouffet*, 149 F.3d [1350,] 1355-59 [(Fed.Cir.1998).] This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. See id. at 1344-45."

Here, in this application the examiner has clearly used improper hindsight reconstruction to reject these claims. Not only is there a lack of motivation to combine *any* of the cited references that are relied upon by the examiner, the examiner admits that the references themselves need to be *modified* as part of the combination. There is no motivation for the combinations or the modifications to the combinations except for the vague, conclusory statements that "it would have been obvious to one of ordinary skill in the art" to do so. The examiner further states that not only would it have been obvious to one of ordinary skill in the art at the time that the invention was made to provide a lens taught by Wu on the *modified* device of Maier, but *that the lens itself had to be modified* to employ a lighting assembly as taught by Anderson.

It is submitted that there is no motivation supplied by any of these references to combine them with the others, and there is no motivation to *modify* them in the manner suggested. It can only be done as a result of using the applicant's claims as a roadmap to locate features that purportedly meet the claims.

Applicant continues to believe that claim 1 is not taught or suggested by Maier or Anderson, or the other references of record, applied singularly or in combination with one another. The examiner states that Maier shows an *attachment* for a power driven wrench. It is still believed that this is a mischaracterization of what is disclosed in Maier inasmuch as it is not an attachment, but is in fact a power driven wrench. It is clearly a tool as opposed

to an attachment for a tool and it is driven by being connected to a source of positive air pressure.

Anderson is similarly a pneumatic power driven tool that is driven by a source of positive air pressure and it too is a tool rather than an attachment for a tool. The examiner states that Anderson shows a generator and light for a power tool similar to that of Maier and that "obviously one of ordinary skill in the art would add such a light to the device of Maier." It is believed that this statement is largely irrelevant for the reason that adding a light to Maier still does not teach or suggest a right angle *attachment* for a power hand tool as is claimed. It is also a conclusory statement that is not supported by any reference to prior art and is therefore believed to be improper.

Neither Maier nor Anderson disclose an attachment for a power hand tool wherein the attachment has the structure as claimed. The examiner also states that "lenses are old and such lighting would be obvious to use with such a device." This is the type of conclusory statement that the *Kahn* decision indicates is improper. Similarly, the examiner states that driving a saw in place of a drill is "old" and would be obvious to add to the Maier device to increase its versatility. However, this is again a conclusory statement and the Maier patent specifically states that it is a wrench. The examiner also states that compression band mountings are "old" and would be a mechanical equivalent to the threads of Maier. This is another conclusory statement that is improper.

What is clear from the examiner's statements is that neither Maier or Anderson disclose an *attachment* for a power tool, which is what applicant claims in claim 1. Neither Maier nor Anderson teach or suggest a lens in the housing adjacent said light producing device for admitting light to the exterior of said housing toward a tool attached to said distal end. Anderson mentions the word lens, but the face plate 60 is not a lens and in fact does not cover the lamps 54. More particularly, the specification at col. 5, lines 50-62 states that the preferred embodiment of the face plate is made of aluminum and specifically shows and describes cutouts 70 for permitting light to be directed

outwardly. Neither Maier nor Anderson teach or suggest a housing having a mounting end and a distal end with the mounting end having a cylindrical opening sized to snugly fit on the nose end portion of the tool housing. Neither Maier nor Anderson teach or suggest a housing having an input shaft journaled in bushings and having an engaging recess at one end portion for engaging a drive shaft that is driven by the motor output shaft and an attached gear at the opposite end.

The dependent claims necessarily incorporate the features of the claims from which they depend in addition to defining other features and/or functionality and are therefore believed to be in condition for immediate allowance.

**Claim 1 Is Improperly Rejected Based Upon The Combination Of Kopras And Anderson**

The examiner has also rejected claims 1-4 and 8-9 under 35 U.S.C. 103(a) as being unpatentable over Kopras in view of Anderson. It is strongly believed that there is no motivation for combining these references and that the only reason to do so is a result of hindsight reconstruction. The discussion of *Kahn* with regard to the Maier/Anderson rejection equally applies here.

As previously stated, Anderson mentions the word lens, but the face plate 60 is not a lens and in fact does not cover the lamps 54. More particularly, the specification at col. 5, lines 50-62 states that the preferred embodiment of the face plate is made of aluminum and specifically shows and describes cutouts 70 for permitting light to be directed outwardly. While Kopras is an attachment, the examiner admitted that it showed "the invention substantially as claimed except for a magnet, an electrical circuit including at least one light producing device and a lens". What it did not show are the elements that are the heart of the invention, and even assuming that Anderson could be properly combined with Kopras, Anderson does not supply the deficiencies of Kopras, particularly the lens element as claimed.

**Claims 6 and 7 are improperly rejected based upon the combination of the Rubly, Maier, Dukess, Anderson, Kopras and Wu references.**

It is also strongly believed that there is no motivation for combining six references. It is almost inescapable that the examiner used the claims as a roadmap to make construct such a rejection. Clearly, such a rejection crosses the line of reasonableness and is a clear demonstration of improper hindsight reconstruction. The Court of Appeals for the Federal Circuit has addressed this issue in many of its decisions, of which the following is appropriate:

> In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Co.,* 713 F.2d 693, 698 (Fed.Cir.1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result-often the very definition of invention.

*Ruiz v. A.B. Chance Co.* 357 F.3d 1270, 1276 (Fed.Cir. 2004).

It is submitted that there cannot be independent motivation to combine six different patents, particularly in this instance when none of them provides any motivation to combine or be combined with the others.

Additionally, these claims also incorporate the features of claim 1 from which they depend in addition to defining other features and/or functionality and are therefore believed to be in condition for immediate allowance. If the rejection of claim 1 is reversed, these claims 6 and 7 should also be allowed for that reason.

## CONCLUSION

The dependent claims necessarily incorporate the features of the claims from which they depend in addition to defining other features and/or functionality and are therefore believed to be in condition for immediate allowance. If the rejection of claim 1 is reversed, claims 2-4 and 6-8 should be allowed.

For the above reasons, applicant requests the Board to reverse the outstanding rejections. The case should then be permitted to pass to allowance.

Respectfully submitted,

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## CLAIMS - APPENDIX

1. A right angle attachment for a power hand tool of the type which has an elongated generally cylindrical housing containing a motor having a motor output shaft extending from a nose end thereof, the housing having a generally cylindrical nose end portion that is concentric with said motor output shaft, said nose end portion providing a structure on which said attachment can be mounted, said attachment comprising:

a housing having a mounting end and a distal end, with the mounting end having a cylindrical opening sized to snugly fit on the nose end portion of the tool housing;

said housing having an input shaft journaled in bushings and having an engaging recess at one end portion for engaging a drive shaft that is driven by the motor output shaft, and an attached gear at the opposite end;

said housing having an output shaft journaled in bushings, said output shaft being configured to rotate a tool attached to said distal end, and having a gear attached to its opposite end portion ;

said input shaft gear engaging said output shaft gear at a generally 90 degree angle so that said motor output shaft drives said accessory output shaft;

a magnet mounted on said output shaft and an electrical circuit mounted in said attachment housing adjacent said magnet for producing power, said circuit including at least one light producing device;

a lens in said housing adjacent said light producing device for admitting light to the exterior of said housing toward a tool attached to said distal end.

2. An attachment as defined in claim 1 wherein light producing device comprises at least one LED.

3. An attachment as defined in claim 1 wherein said electrical circuit comprises a printed circuit board having conductive lines and circuit components including at least one inductor attached thereto, said printed circuit board being in sufficiently close proximity to said magnet so that

rotation of said magnet causes the magnetic field of the magnet to induce a current in said inductor for driving said light producing device.

4. An attachment as defined in claim 3 wherein said magnet has at least two poles and is generally in the shape of a ring that fits around said accessory output shaft.

5. A right angle attachment for a power hand tool of the type which has an elongated generally cylindrical housing containing a motor having a motor output shaft extending from a nose end thereof, the housing having a generally cylindrical nose end portion that is concentric with said motor output shaft, said nose end portion providing a structure on which said attachment can be mounted, said attachment comprising:

a housing having a mounting end and a distal end, with the mounting end having a cylindrical opening sized to snugly fit on the nose end portion of the tool housing;

said housing having an input shaft journaled in bushings and having an engaging recess at one end portion for engaging a drive shaft that is driven by the motor output shaft, and an attached gear at the opposite end;

said housing having an output shaft journaled in bushings, said output shaft being configured to rotate a tool attached to said distal end, and having a gear attached to its opposite end portion ;

said input shaft gear engaging said output shaft gear at a generally 90 degree angle so that said motor output shaft drives said accessory output shaft;

a magnet mounted on said output shaft and an electrical circuit mounted in said attachment housing adjacent said magnet for producing power, said circuit comprising at least one light producing device, and a printed circuit board having conductive lines and being in sufficiently close proximity to said magnet so that rotation of said magnet causes the magnetic field of the magnet to induce a current in inductors for driving said light producing device, said circuit further comprising two inductors and two LEDs connected in parallel with one another, said two LEDs being connected such that the anode of one is

connected to the cathode of the other, said inductors being located at approximately the same radius relative to the axis of said output shaft, but arcuately spaced from one another by approximately 90 degrees; and

a lens in said housing adjacent said light producing device for admitting light to the exterior of said housing toward a tool attached to said distal end.

6. An attachment as defined in claim 1 wherein said lens has an elongated narrow configuration angled toward the end of said attachment output shaft, the outer surface thereof being generally coextensive with the outer surface of said housing, and made of a transparent plastic material.

7. An attachment as defined in claim 1 wherein said attachment housing mounting end further comprises a compression band extending generally around the outer surface thereof and having a lever mechanism that can be moved between loosened and tighten positions.

8. An attachment as defined in claim 3 wherein said printed circuit board has a generally circular shape with a portion removed that extends from the center to the outer periphery thereof, said portion having a width greater than said output shaft so that said printed circuit board can be easily placed in said housing around said output shaft during assembly of said attachment.

9. An attachment as defined in claim 1 wherein said distal end has a generally cylindrical outer surface configured to receive a saw guard when a circular saw blade is attached to said attachment output shaft.

10. An attachment as defined in claim 1 wherein said engaging recess is a square recess.

11. A right angle saw attachment for a power hand tool of the type which has an elongated generally cylindrical enclosure containing a motor having a motor output shaft extending from a nose end thereof, the enclosure having a generally cylindrical nose end portion that is concentric with said motor output shaft, said nose end portion providing a structure on which said attachment can be mounted, said attachment comprising:

a housing having a mounting end and a distal end, with the mounting end having a cylindrical opening sized to snugly fit on the nose end portion of the tool enclosure and the distal end has a generally cylindrical outer surface configured to receive a saw guard when a circular saw blade is attached to said attachment output shaft;

said housing having an input shaft journaled for rotation and having a recess at one end portion configured to engage a drive shaft that is operably driven by the motor output shaft, and a first bevel gear attached to the opposite end;

said housing having an output shaft journaled for rotation, said output shaft being configured to rotate a saw blade attached to an exposed end portion, and having a second bevel gear attached to its opposite end portion ;

said first bevel gear engaging said second bevel gear at a generally 90 degree angle so that said motor output shaft effectively drives said accessory output shaft;

a magnet mounted on said attachment output shaft and configured to be rotated to produce an alternating magnetic field;

an electrical circuit mounted in said attachment housing adjacent said magnet, and comprising a printed circuit board having conductive lines and two inductive coils and two light producing diode devices, wherein said coils and devices are connected in parallel with one another, said two diode devices being connected such that the anode of one is connected to the cathode of the other, said inductive coils being located at approximately the same radius relative to the axis of said output shaft, but angularly spaced from one another by approximately 90 degrees, and being proximate said magnet in said circuit for generating an electric current from said magnetic fields, said printed circuit board being in sufficiently close proximity to said magnet that rotation of said magnet causes the magnetic field to induce a current in said inductive coil;

at least one device in said circuit for producing light when electric current is generated; and

a lens in said distal end of said housing adjacent said light producing device for admitting light to the exterior of said housing toward said saw blade attached to said exposed end.

12. Cancelled.

13. An attachment as defined in claim 11 wherein said magnet has at least two poles and is generally in the shape of a ring that fits around said accessory output shaft.

14. Cancelled

## EVIDENCE - APPENDIX

None.

## RELATED PROCEEDINGS- APPENDIX

None.